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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,148	03/12/2004	Dan Mielke	9458.4895	5942
22235	7590	11/09/2006	EXAMINER	
MALIN HALEY AND DIMAGGIO, PA			KUHN, ALLAN R	
1936 S ANDREWS AVENUE			ART UNIT	
FORT LAUDERDALE, FL 33316			PAPER NUMBER	

1732

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/799,148

Applicant(s)

MIELKE ET AL.

Examiner

Allan Kuhns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 13, drawn to a method for manufacturing vehicle hulls, classified in class 264, subclass 46.5.
- II. Claims 11, 12, 14 and 15, drawn to a vehicle hull, classified in class 114, subclass 357.

2. The inventions are independent or distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product structure as claimed, or as imputed from the steps practiced, can be made by another and materially different process such as forming hull top and bottom portions in separate molds and subsequently assembling an adhesively attaching the top and bottom portions outside the confines of either mold.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art requiring divergent fields of search for the respective inventions, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Dale Paul DiMaggio on November 6, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10 and 13. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 11, 12, 14 and 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite because it is unclear as to whether or not the protective coating is the gel coat or is some other coating layer, such that the initial steps of claim 1 lack a nexus between them. In addition, claim 7 now ends in a semicolon. Clarification is required.

6. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. (3,124,626) in view of Hegg (3,531,809) and Hordis (5,372,763). Graham et al. disclose or suggest the basic claimed method for manufacturing vehicle hulls including (1) applying a protective or gel coating to top and bottom molds (column 3, lines 35-43), (2) applying an inner skin coat (a glass fiber layer) on the protective coat or gel coat on the top and bottom molds, (column 3, lines 70-75), (3) closing the top and bottom molds together, (4) creating a piece having at least one cavity, (5) forming at least one cavity through the piece and into the cavity (note figure 4), and (6) introducing foam into the cavity through the foam introduction hole. Graham et al. appear not to teach the application of an additional layer to the gel coat but such is taught or suggested by Hegg at column 2, line 70 to column 3, line 5. Hegg actually teaches that there may be more than one glass fiber reinforced layers applied to a gel coat. It would have been obvious to one of ordinary skill in the art to incorporate this teaching of Hegg into the method of Graham in order to provide additional backing for

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the gel coat layers. Graham et al. also do not teach the aspect of applying an adhesive to top and bottom mating portions of bonding surfaces, but such is taught by Hordis at column 4, lines 48-50 in forming an integral portion of a boat hull, as set forth at column 4, lines 32 and 33. It would have been obvious to one of ordinary skill in the art to incorporate this teaching into the method of Graham et al. in order securely form a perimeter of the boat hull. Hordis also teaches the aspect of forming holes in a piece, which allows the passage of foam, at column 4, lines 43-47.

7. Graham et al. teach the forming of holes, as in claim 3, and curing, as in claim 6. Providing reinforcement, as in claims 4 and 5, is well known and would have been obvious to one of ordinary skill in the art in order to strengthen the hull.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. in view of Hegg and Hordis as applied to claims 1 and 3-6 above, and further in view of Stoeberl (3,840,926). Also in forming a boat hull, Stoeberl teaches at column 17, lines 19-34 that it is important that a connecting synthetic plastics layer or adhesive not become too thick. Given this teaching of Stoeberl, it would have been obvious to one of ordinary skill in the art to limit the thickness of an adhesive taught by the prior art relied upon to within the range of claim 2 in order to prevent its thickness from becoming excessive.

9. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. in view of Hegg and Hordis as applied to claims 1 and 3-6 above, and further in view of Kurtz et al. (4,568,604). Kurtz et al. disclose the necessity of removing air during the manufacture of glass fiber reinforced composites with gel coats (note

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column 1, lines 35-52), including processes of manufacturing hulls. It would have been obvious to one of ordinary skill in the art to remove air, as taught by Kurtz et al., in order to avoid the formation of permanent voids. The means of air removal recited in dependent claims are well known and would have been obvious to one of ordinary skill in the art in order to expediently eliminate voids.

10.Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoeberl (3,840,926). Stoeberl discloses or suggests the basic claimed method for manufacturing at least partially hollow vehicle hulls including (1) placing a top hull layer having a top mating surface within a top mold, (2) placing a bottom hull layer having a bottom mating surface within a bottom mold, (3) placing an adhesive on at least one mating surface (note that at column 17, lines 19-25 the synthetic plastics connection layer is characterized as an adhesive), and (4) closing the top mold and the bottom mold together and allowing the adhesive to cure or set (column 15, lines 30-39). A unitary piece is formed within the closed molds. Stoeberl appears not to explicitly teach that the adhesive is "structural", but use of such an adhesive would have been obvious to one of ordinary skill in the art in order to cause the boat hull to remain intact.

11.The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,726,865 in view of Graham et al. or Hordis. In claims 1-7 of the '865 patent, the basic claimed process of preparing and adhering outer layers of a boat hull are claimed, but the aspects of creating a piece including at least one cavity, forming at least one foam introduction hole through the outer surface of the piece into the cavity in the piece, and introducing foam into the cavity in the piece through the foam introduction hole are not claimed. However, these aspects are taught by each of Graham et al. and Hordis. It would have been obvious to one of ordinary skill in the art to incorporate these aspects into the claimed process of the '865 patent in order to complete the forming of the boat hull.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (571) 272-1202. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on (571) 272-1176. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Allan R. Kuhns*

ALLAN R. KUHNS  
PRIMARY EXAMINER AU 1732

11-7-06